D. REMARKS

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

Interview Summary

On September 23, 2004 at 3:00 PM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiners Rasha Al Aubaidi and Ahmad Matar. No exhibits were shown, nor demonstrations conducted.

First, Applicants' representative and the Examiners discussed claim 1, and in particular the lack of motivation in the prior art or knowledge in the art or specified in the office action to combine Biorge in view of Walker. Specifically, the prior art cited against claim 1 are the US Patents to Biorge (US Patent) and Walker (U.S. Patent 6,125,178). Applicants representative argued that Biorge is a transactional based system that does not suggest combination with a telephony based system. Further, Applicants representative argued that Biorge is not analogous to the present invention because the present invention is a telephony based system. The Examiners responded that a reversal of the references would make more sense, but that the current references are not defective.

Second, Applicants' representative and the Examiners discussed claim 8, in particular the lack of a specific rejection with reference to the teachings of claim 8. Specifically, claim 8 is rejected for the same reasons as claim 1. Applicants' representative argued that claim 8 includes multiple limitations, none of which are specifically responded to in the Office Action. The Examiners responded that claim 8 just provides examples of the elements in claim 1, and that there is not a need for a specific reference to the limitations in claim 8.

No agreement was reached with respect to claim 1 or claim 8. Applicant is filing this response for further review by the Examiner.

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Election

The Examiner placed a restriction on the application, dividing the claims into group I of claims 1-27 and 40-41 and group II of claims 28-39. In an oral interview, Applicants' representative elected to proceed with group I. Applicants' representative affirms the election to proceed with group I, but retain the right to present cancelled claims 28-39 in a divisional application as provided under 35 U.S.C. 121.

In addition, Applicants note that in paragraph 1, the Examiner reminds Applicant to amend the inventorship after electing claims, if needed. In the present application, inventorship has not changed as a result of the claims cancellation.

35 USC § 103(a)

Applicants note the responsibility under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants note that all claims are commonly owned.

Claims 1-27 and 40-41

Claims 1-27 and 40-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Biorge (US Patent 5,806,045) in view of Walker et al. (US Patent Number 6,088,444). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 1-27 and 40-41, the rejection should be withdrawn and the claims should be allowed.

Claims 1, 2, 8, 12, 22, 27, and 40-41

Regarding claim 1, the Examiner notes Biorge as teaching:

"a system and method for allocating and redeeming incentive credit for a customer that enters into a transaction with one of the providers participating in the incentive system (70) (see abstract and Fig. 3). Biorge also teaches that after the incentive credits will be deleted and the customer identity will be recognized

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(see col. 5, lines 3-16), customer can choose to redeem some or all of his/her

incentive credits (see col. 2, lines 50-67)." [Office Action, p. 4]

The Examiner notes, however, that Biorge does not specifically teach that "the incentive credits

are used to advance or adjust the waiting position for a caller waiting in a hold queue." [Office

Action, p. 4] The Examiner cites Walker, however, as teaching a system and method which

"allows the called site to exercise control over the position in a phone queue of an incoming call"

and that based on "certain information within the incoming call such as caller identity and

quantity of items, the amount or value of the order, the call position in the queue will be adjusted

(see Abstract)." [Office Action, p. 4] The Examiner concludes, that it would have been obvious

to one of ordinary skill in the art at the time the invention was made to "incorporate the feature

of adjusting the position of a call in a call queue based on certain parameters, as taught by

Walker into the Biorge system in order to first encourage customers to earn more of those

incentive credits, which are helpful to advance their positions in call queues within any call

center or any other facility" and that second, the "idea of providing an incentive credit to

customer is definitely will improve the call center and further will enhance the level of

satisfaction to its customers." [Office Action, p. 5]

Claim 1 currently reads as follows:

1.(Original) A method for caller position management within a hold queue
comprising:

detecting an advancement token earned by a caller waiting in a hold

queue; and

storing said advancement token for redemption in a future call by said

caller according to an authenticated identifier for said caller, wherein future

redemption of said advancement token will cause adjustment of a waiting

position.

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The Examiner carries the burden of proving a prima facie case of obviousness for a

103(a) rejection. Applicants respectfully assert that the Examiner does not establish prima facie

obviousness for claims 1 for the following reasons.

First, to rely on a reference as a basis for a rejection under 35 U.S.C. 103, the reference

must be analogous prior art, and in particular the reference must either be in the field of the

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which

the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed.

Cir. 1992). Applicants respectfully assert that Biorge is a transactional based system that focuses

on storing customer incentive points on a "customer-carried portable device", which is similar to

a credit card, that the customer swipes at a provider device to complete a transaction; if a

incentive points may be stored on the customer-carried device as a result of the transaction. (See

Abstract) In contrast, the present invention focuses on a "caller waiting in a hold queue", which

implies that the invention is within the field of telephony, rather than within the field of physical

credit card based transactions. Thus, where the Examiner uses Biorge as a basis for the rejection

under 35 U.S.C. 103, the rejection is improper because Biorge is within a field, credit card

transactions, that is not within the field of telephony.

Second, in establishing prima facie obviousness under 103(a), there must be some

suggestion or motivation to modify the references. In particular, the teaching, suggestion or

motivation to combine or modify the teachings of the prior art to produce the claimed invention

must be found either explicitly or implicitly in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596

(Fed. Cir. 1988). The Examiner cites Biorge as teaching the elements of claim 1, except for not

specifically teaching that the incentive credits are used to advance or adjust the waiting position

for a caller waiting in a hold queue and cites Walker as teaching a system and method which

allows the called site to exercise control over the position in a phone queue of an incoming call

[Office Action, p. 4] The Examiner concludes that it would have been obvious to one of skill in

the art to incorporate the feature of adjusting the position of a call in a call queue based on

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certain parameters, as taught by Walker, into the Biorge system, to first encourage customers to earn more of those incentive credits, which are helpful to advance their position in call queues within any call center. [Office Action, p.4] As previously discussed, Biorge is a transactional service relating to credit card transactions where the credit card holds the incentive credits; Walker is a call center based service. Applicants respectfully note that there is not a suggestion or motivation in the prior art or the knowledge available to one with skill in the art of transactional services or call centers to combine a credit card transactional based service that focuses on the customer carrying the incentives on a card with a call center service. Further, there is no suggestions in Walker that a caller's adjustment of position within a hold queue could be based on redeemed incentive points. Thus, Applicants respectfully assert that there is not an articulation or the suggestion or motivation to modify the references and that the references themselves do not suggest or motivate modification.

Third, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner cites Biorge col. 5, lines 3-16 as teaching that the customer identity is recognized. [Office Action, p. 4] Biorge col. 5, lines 3-10 teaches:

> "the user of the device (the customer) is checked to determine whether he is a valid user. User verification is preferably performed by requiring that the user enter a user code and comparing the entered user code with a reference user code stored within the portable device. Only if both the portable device and the user are valid will a transaction between a customer and a provider be allowed to take place."

Thus, the Examiner equates a code entry system as teaching that "the customer identity is recognized" and then equates "the customer identity is recognized" as teaching an "authenticated identity."

Applicants respectfully assert that Biorge only teaches customer validity, which under its ordinary definition does not teach not customer identity recognition. In addition, Applicants respectfully assert that customer validation does not teach identity authentication. The Free On-

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Line Dictionary of Computing defines authentication as "the verification of the identity of a person or process." In addition, the specification teaches identity authentication at p. 15 line 24- p. 16 line 3 as:

> "An authentication service within telco application server 22 may include identification and verification of the identity of a caller and/or callee of a particular call. Such a service may require that subscribers provide voice samples when setting up a subscription. The stored voice samples may then be compared against voice samples received for a particular call in order to authenticate the identity of a current caller or callee of the particular call."

Thus, while the customer verification of Biorge teaches validating that expected numbers are punched in, authentication implies using some method that actually verifies who the customer is. Therefore, because the user code entry of Biorge does not teach or suggest an authenticated identity, prima facie obviousness is not shown and the claims should be allowed.

Therefore, for the foregoing reasons, because the Examiner does not prove a prima facie case of obviousness, Applicants respectfully request allowance of method claim 1 and corresponding system and program claims 11 and 21. In addition, claims 2, 8, 12, 22, 27, and 40-41 are rejected for the same reasons as claim 1. Thus, Applicants respectfully request allowance of claims 2, 8, 12, 22, 27, and 40-41 for the same reasons as allowance of claim 1.

In addition, regarding claims 8, 18, and 27, Applicants respectfully note that the Examiner does not prove prima facie obviousness because the combined prior art references do not teach or suggest all the claim limitations.

Claim 8 currently reads as follows:

8.(Original) The method for caller position management within a hold queue according to claim 1, wherein said detecting an advancement token further comprises:

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detecting said advancement token earned by a caller by participating in at
least one from among a competition, a survey, and a redemption of membership
points.

In establishing a prima facie case of obviousness under 103(a), the combined prior art
references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20
USPQ2d 1438 (Fed Cir. 1991). Claim 8 is rejected for the same reasons as claim 1. During the
interview, Examiner Matar acknowledged that the rejection of claim 1 does not specifically show
how the prior art references teach or suggest claim 8, but the Examiner said claim 8 just includes
examples of how to earn credits, and thus these examples are covered within the rejection of
claim 1. Applicants respectfully assert, however, that claim 8 includes additional limitations,
each of which must specifically be shown to be taught or suggested by the combined prior art
references. Because the Examiner fails to show how the combined prior art references teach or
suggest the limitations of claim 8, Applicants respectfully assert that prima facie obviousness is
not proved and respectfully request allowance of method claim 8 and corresponding system and
program claims 18 and 27.

<u>Claims 3, 13 and 23</u>

Regarding claim 3, Applicants respectfully assert that the Examiner does not prove prima
facie obviousness because the combined prior art references do not teach or suggest all the claim
limitations.

Claim 3 currently reads:
3.(Original) The method for caller position management within a hold queue
according to claim 1, wherein storing said advancement token further comprises:

storing said advancement token according to said authenticated identifier
at a caller profile server accessible to a plurality of a call centers, wherein said

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advancement token is redeemable across a selection of said plurality of call
centers for said future call.

In establishing a prima facie case of obviousness under 103(a), the combined prior art
references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20
USPQ2d 1438 (Fed Cir. 1991). The Examiner cites "storing said advancement token according
to said authenticated identifier at a caller profile server" as reading on Biorge's customer-carried,
portable device (see abstract, col. 2, lines 26-33 and lines 50-65). [Office Action, p. 5] A
customer carried, portable device implies, by its name and description, a portable device that the
customer retains. In the Free On-Line Dictionary of Computing (copyright 1993-2004 Denis
Howe, available via http://www.dictionary.com), a "device" is defined as a "peripheral" which is
further defined as "Any part of a computer other than the CPU or working memory...." Further,
Biorge specifies, in the abstract that data is "stored on the customer-carried device" and that "by
using a customer-carried device, transactions may be conducted off-line." Thus, Applicants
respectfully assert that a customer-carried device is merely a storage medium, independent of a
computer system.

In contrast, the present invention describes storing the advancement token at a call profile
server accessible to multiple call centers. In the Free On-Line Dictionary of Computing
(copyright 1993-2004 Denis Howe, available via http://www.dictionary.com), a "server" is
defined as "a computer which provides some service for other computers connected to it via a
network." Further, the specification illustrates the caller profile server as accessible via a
network (p. 29, lines 7-8 read: As illustrated, on hold system 42 accesses caller profile server 50
via network 20). Applicants respectfully assert that a storage medium alone, as taught by the
customer-carried device of Biorge, does not teach a server system, which by its ordinary
meaning is at least a computer that provides services via a network. Therefore, because the
Examiner fails to show how the combined prior art references teach the limitations of claim 3,
Applicants respectfully assert that prima facie obviousness is not proved and respectfully request
allowance of method claim 3 and corresponding system and program claims 13 and 23.

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Claims 4, 5, 14, 15, 23, and 24

Regarding claim 4, Applicants respectfully assert that the Examiner does not prove prima facie obviousness because the combined prior art references do not teach or suggest all the claim limitations.

Claim 4 currently reads:

4.(Original) The method for caller position management within a hold queue according to claim 1, wherein storing said advancement token further comprises:

storing said advancement token according to said authenticated identifier at a caller profile server accessible to said hold queue, wherein said advancement token is only redeemable at said hold queue for said future call.

The Examiner uses the same rationale for rejecting the "caller profile server" of claim 4, as was used with reference to claim 3. As previously asserted by the Applicant with reference to claim 3, the customer carried device of Biorge does not teach the caller profile server of the present invention. Therefore, because the Examiner fails to show how the combined prior art references teach the limitations of claim 4, Applicants respectfully assert that prima facie obviousness is not proved and respectfully request allowance of method claim 4 and corresponding system and program claims 14 and 23. In addition, the Examiner rejects claims 5, 15, and 24 for the same reasons as claims 4, 14, and 23, therefore Applicants respectfully request allowance of claims 5, 15, and 24 for the same reasons for allowance of claims 4, 14, and 23.

Claims 7, 17, and 27

Regarding claim 7, Applicants respectfully assert that the Examiner does not prove prima facie obviousness because the combined prior art references do not teach or suggest all the claim

limitations. In addition, Applicants traverse the Examiner's assertion of what is well known in the art.

Claim 7 currently reads:

7.   (Original) The method for caller position management within a hold queue according to claim 1, wherein said authenticated identifier for said caller is authenticated according to a voice identity of said caller.

First, the Examiner claims that both Biorge and Walker teach identifying the caller or the customer by having him/her enter a pass code or some sort of authentication number, but not authentication according to voice identity. [Office Action, p. 6] The Examiner cites that authentication according to voice identity is obvious and well-known. [Office Action, p. 6] In addition, the Examiner states that "as a matter of fact, many references teach the use of voice recognition, which is an old and well-known feature in the art." [Office Action, pp. 6-7]

Applicants traverse the finding, by the Examiner, that at the time of filing, it was considered common knowledge or well-known in the art to use voice recognition. The Examiner merely states that voice recognition is old and well-known, but does not provide any documentary evidence of the well-known nature of the use of voice recognition. Therefore, Applicants request that if the rejection is to be maintained on these grounds that the Examiner provide documentary evidence of the basis of the assertion of what is well known in the art in the next Office Action. 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test.)

Second, Applicants note that in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants assert that use of voice recognition does not teach or suggest voice authentication. The Free On-Line Dictionary of Computing (copyright 1993-2004 Denis Howe, available through http://www.dictionary.com)

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defines voice recognition as the Free On-Line Dictionary of Computing defines authentication as "the verification of the identity of a person or process." Moreover, the specification teaches identity authentication at p. 15 line 24-p. 16 line 3 as:

> "An authentication service within telco application server **22** may include identification and verification of the identity of a caller and/or callee of a particular call. Such a service may require that subscribers provide voice samples when setting up a subscription. The stored voice samples may then be compared against voice samples received for a particular call in order to authenticate the identity of a current caller or callee of the particular call."

Thus, Applicants respectfully assert that voice recognition, which is determining what word is spoken, does not teach or suggest the area of voice authentication, which is verifying the identity of a person by a voice sample." Therefore, because the Examiner fails to show how the combined prior art references, including knowledge in the art, teach the limitations of claim 7, Applicants respectfully assert that prima facie obviousness is not proved and respectfully request allowance of method claim 7 and corresponding system and program claims 17 and 27.

Claims 9 and 19

Regarding claims 9 and 19, Applicants respectfully propose that because Biorge in view of Walker no longer anticipates the independent claims 1 and 11 upon which these dependent claims rely, then Walker does not anticipate these dependent claims and the dependent claims should be allowed.

Claims 10 and 20

Regarding claims 10 and 20, Applicants traverse the Examiner's assertion of what is well known in the art.

Claim 10 currently reads:

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10.   (Original) The method for caller position management within a hold
queue according to claim 1, wherein redemption of said advancement token
advances said caller a particular amount of estimated wait time.

The Examiner cites Walker as teaching "the use of IVRU, which responsive of delivering
prompts and messages to customers as well as conducting information from the customer."
[Office Action, p. 7] Then, the Examiner concludes that "obviously, customer must be informed
about the estimated wait time. In fact the feature of announcing the remaining estimated wait
time is almost inherent in a call queues within a call center." [Office Action, p. 7]

Applicants traverse the finding, by the Examiner, that at the time of filing, it was
considered common knowledge or well-known that a customer must be informed about an
estimated wait time while waiting in a hold queue. The Examiner merely states that it is almost
inherent in call queues within a call center to provide the feature of announcing the remaining
estimated wait time, but does not provide any documentary evidence of the well-known nature of
the use of voice recognition. Therefore, Applicants request that if the rejection is to be
maintained on these grounds that the Examiner provide documentary evidence of the basis of the
assertion of what is well known in the art in the next Office Action. 37 CFR 1.104(c)(2). See
also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to
some concrete evidence in the record in support of these findings" to satisfy the substantial
evidence test.)

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

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